

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Young et al.
Appl. No.: 10/070,799
Conf. No.: 9555
Filed: September 16, 2002
Title: METHOD FOR IMPROVING THE SKIN AND COAT OF PETS
Art Unit: 1615
Examiner: N.S. Levy
Docket No.: 115808-338

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-COMPLIANT APPEAL BRIEF

Sir:

This Response is submitted in reply to the Notice of Non-Compliant Appeal Brief dated March 11, 2008.

REMARKS

In response to the Notice of Non-Compliant Appeal Brief dated March 11, 2008, Appellants have amended the Appeal Brief to address the informalities cited by the Patent Office. The compliant version of the Appeal Brief, including signature, is attached as Exhibit A without copies of the cited references, affidavits, office actions, advisory actions and responses to office actions, which were previously submitted.

Appellants submit that the present Appeal Brief is compliant under 37 CFR 41.37. Appellants respectfully request reconsideration of the Appeal Brief and submit that the Patent Office has failed to establish a *prima facie* case of obviousness with respect to the rejection of the claimed invention. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and, therefore, should be reversed.

The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115808-338 on the account statement.

Respectfully submitted,


BELL, BOYD & LLOYD LLP

BY _____

Robert M. Barrett
Reg. No. 30,142
Customer No. 29156

Dated: April 8, 2008

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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APPELLANTS' APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on November 21, 2007. This Appeal is taken from the Final Rejection in the Office Action dated August 24, 2007.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on Appeal is Nestec, S.A. by virtue of an Assignment dated September 23, 2002 and recorded at reel 013317, frame 0583-0586 in the United States Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Appellants' legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings that may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33 are pending in the above-identified patent application. Claims 2, 3, 5, 7, 9, 11, 14, 18 and 25-29 were previously canceled. Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33 stand rejected. Therefore, Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33 are being appealed in this Brief. A copy of the appealed claims is included in the Claims Appendix.

IV. STATUS OF AMENDMENTS

A non-final Office Action was mailed March 15, 2007. A final Office Action was mailed on August 24, 2007. In the final Office Action, the Examiner maintained the obviousness rejections. Appellants attach copies of the non-final and final Office Actions as Exhibit A and Exhibit B, respectively, in the Evidence Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the invention by way of reference to the specification and/or figures for each of the independent claims is provided as follows:

Independent Claim 1 is directed to a method of maintaining or enhancing the healthy functioning of the skin and coat system of a pet in need of same (page 2, lines 9-10) comprising the step of feeding the pet a food composition (page 2, line 11) comprising a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet (page 2, lines 12-13), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of the food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of the food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 6 is directed to a method for improving or maintaining the coat of a pet in need of same (page 2, lines 9-10), the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet (page 2, lines 12-13), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 13 is directed to a method for improving or maintaining the coat of a pet in need of same (page 2, lines 9-10), the method comprising administering to the pet a nutritionally complete pet food which contains a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet (page 2, lines 12-13), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of the pet food (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of the pet food (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 20 is directed to a method for improving or maintaining the skin and coat system of a pet in need of same (page 2, lines 9-10), the method comprising administering to the pet a nutritional agent which increases the digestion of nutrients in the gastro-intestinal tract of the pet (page 3, line 11), wherein the nutritional agent comprises a prebiotic that

comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 21 is directed to a method for improving or maintaining the skin and coat system of a pet in need of same (page 2, lines 9-10), the method comprising administering to the pet a nutritional agent which improves the microflora balance on the skin of the pet (page 2, lines 30-34), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 22 is directed to a method for improving or maintaining shininess and softness of the coat of a pet in need of same (page 2, lines 9-10), the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastrointestinal tract of the pet (page 2, lines 12-13), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 23 is directed to a method for improving or maintaining shininess and softness of the coat of a pet in need of same (page 2, lines 9-10), the method comprising administering to the pet a nutritional agent which increases the digestion of nutrients in the gastro-intestinal tract of the pet (page 3, line 11), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 24 is directed to a method of reducing or assisting in the prophylaxis of dandruff in the coat of a pet in need of same (page 3, lines 7-8), the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet (page 2, lines 12-13), wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid (page 3, line 16).

Independent Claim 30 is directed to a method of manufacturing a pet food, the method comprising providing a prebiotic substance that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid in a pet food composition (page 3, line 16) for giving the coat of a pet animal eating it a flourishing appearance (page 4, lines 7-9).

Independent Claim 31 is directed to a method of reducing dandruff in a coat of a pet animal in need of same (page 3, lines 7-8), the method comprising providing a prebiotic substance that comprises about 0.1% to about 20% by weight of a food composition (page 6, lines 23-28), a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition (page 6, lines 29-34), and a long-chain fatty acid in a pet food composition (page 4, lines 7-9) and administering the pet food composition to the pet animal (page 5, lines 24-25).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,156,355 to Shields et al. ("Shields") in view of EP 0862863 to Cavadini et al. ("Cavadini") or WO 98/56263 to Marsh et al. ("Marsh"). Appellants attach copies of *Shields*, *Cavadini* and *Marsh* herewith as Exhibits C, D and E in the Evidence Appendix.
2. Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lowe ("Canine Nutrition – Recent Advances") ("Lowe '88") in view of *Marsh*, *Shields*, LabDiet ("Product Reference Manuel") (*LABDIET '98*), U.S. Patent No. 5,756,088 to Matsuura et al. ("Matsuura"), and *Cavadini*. Appellants attach copies of *Lowe '88*, *LabDiet '98* and *Matsuura* herewith as Exhibits F, G and H in the Evidence Appendix.

VII. ARGUMENT

A. LEGAL STANDARDS - Obviousness under 35 U.S.C. § 103

The Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. § 103 is:

whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness...Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). This burden may only be overcome "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings." *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

Moreover, the Patent Office must provide explicit reasons why the claimed invention is obvious in view of the prior art. The Supreme Court emphasized that when formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to "determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR v. Teleflex*, 127 S.Ct. 1727, 82 USPQ2d 1385 (U.S. 2007).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). "A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged

from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

B. THE CLAIMED INVENTION

Independent Claims 1, 6, 13, 20-24 and 30-31 recite, in part, a method of maintaining or enhancing the coat of a pet in need of same comprising the step of feeding the pet a food composition comprising a nutritional agent comprising a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid. Teachings and examples in the specification supporting and elucidating the scope of the present invention include page 2, lines 9-12; page 6, lines 23-28 and 29-34, and page 3, line 16.

C. THE REJECTION OF CLAIMS 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 AND 30-33 UNDER 35 U.S.C. §103(A) SHOULD BE REVERSED BECAUSE THE CITED REFERENCES FAIL TO DISCLOSE OR SUGGEST ALL THE ELEMENTS OF THE CLAIMS

1. The Cited References

The Examiner in the Final Office Action dated August 24, 2007 asserts that *Shields* in view of *Cavadini* or *Marsh* render obvious Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33. The Examiner also asserts that *Lowe '88* in view of *Marsh*, *Shields*, *LabDiet '98*, *Matsuura* and *Cavadini* render obvious Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33. Even if the cited references are combinable, which Appellants submit they are not, the cited references fail to disclose or suggest every element of independent Claims 1, 6, 20-24 and 30-31.

2. *Shields* in view of *Cavadini* or *Marsh* fail to disclose or suggest every element of Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33

Independent Claims 1, 6, 13, 20-24 and 30-31 recite, in part, a method comprising feeding a pet a food composition comprising a nutritional agent comprising a prebiotic that

comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

Contrary to the pending claims, *Shields* fails to disclose or suggest a nutritional agent comprising a prebiotic that comprises about 0.1% to about 20% by weight of a food composition as required, in part, by the present claims. The Examiner admitted the same in the non-final Office Action dated March 15, 2007. See, non-final Office Action, page 2 (Exhibit A).

Appellants further submit that *Cavadini* and *Marsh* fail to remedy the deficiencies of *Shields*. With regard to *Cavadini*, the Examiner relied on page 5, lines 22-26 and 54-57 to attempt to remedy the admitted deficiencies of *Shields*. See, non-final Office Action, page 2 (Exhibit A). Specifically, those passages of *Cavadini* state as follows:

The dried, ready-to-eat cereal product conveniently contains about 10^4 to about 10^{10} cells of the probiotic micro-organism per gram of the dried cereal product; preferably about 10^6 to about 10^8 cells of the probiotic micro-organism per gram. The dried cereal product may contain about 0.5% to about 20% by weight of the mixture of the probiotic micro-organism and carrier substrate; preferably about 1% to about 6% by weight; for example about 3% to about 6% by weight.

The amount of the dried, ready-to-eat cereal product to be consumed by the human or animal to obtain a beneficial effect will depend upon the size and age of the human or animal. However, an amount of the dried, ready-to-eat cereal product to provide a daily amount of about 10^6 to about 10^9 cells of the probiotic micro-organism would usually be adequate. [EMPHASIS ADDED]

See, *Cavadini*, page 5, lines 22-26 and 54-57 (Exhibit D). Though the Examiner asserts that *Cavadini* remedies the deficiencies in *Shields*, the above passages clearly describe a dried, RTE product containing probiotic microorganisms rather than prebiotics as required, in part, by the present claims and lacking in *Shields*.

With regard to *Marsh*, the Examiner asserted that *Marsh* remedied *Shields*' deficiencies by relying on the teaching of unspecified probiotic-Brewer's yeast at 1.7% on page 16 of *Marsh*. See, non-final Office Action, page 2 (Exhibit A). Similar to *Cavadini*, however, *Marsh*, at best, teaches use of probiotics rather than prebiotics. In fact, nowhere does *Marsh* teach use of prebiotics at any level. Instead, *Marsh* teaches a dietary supplement comprising zinc and linoleic acid. See, *Marsh*, Abstract (Exhibit E).

The Examiner asserted, however, that it would have been obvious at time of the invention for one of ordinary skill in the canine feed arts to apply the desired amounts and proportions of nutrient and dietary aids to optimize desired effects. Moreover, the Examiner asserted that no

objective showing of non-obvious or unexpected results was shown to distinguish over the prior art. See, non-final Office Action, page 2 (Exhibit A). Appellants respectfully disagree.

Appellants have surprisingly found that administering to a pet a nutritional agent that promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet improves, or at least maintains, the condition of the skin and coat system of the pet. Moreover, increasing the concentrations of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet produces nutrients and/or increases the absorption of nutrients that are responsible for the improvement or maintenance of the condition of the skin and coat of the pet. Further, increasing the concentrations of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet are thought to promote a better microflora balance on the skin or the pet. See, specification, page 3, line 33 to page 4, line 9. Moreover, Appellants have observed that the combination of prebiotic with linoleic-acid rich oil, such as soybean oil, provides unexpected benefits that suggest a synergistic effect. See, specification, page 7, lines 14-17. Further, Appellants' Examples establish that when adding prebiotics into a pet food composition at the claimed ranges, numerous benefits arise such as, for example, increased coat shininess, coat softness, skin hydration score and skin elasticity, as well as reduced transepidermal water loss, oxidative stress, inflammation and dandruff. See, specification, page 9, lines 29-34; page 10, lines 25-31, and page 12, lines 1-3 and 30-33.

Therefore, Appellants establish non-obvious and unexpected results distinguishing the present invention over the prior art. Accordingly, the cited references, taken together, fail to disclose or suggest all the elements of present claims.

3. *Lowe '88 in view of Marsh, Shields, LabDiet '98, Matsuura and Cavadini fail to disclose every element of Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33*

Independent Claims 1, 6, 13, 20-24 and 30-31 recite a method of maintaining or enhancing the coat of a pet in need of same comprising the step of feeding the pet a food composition comprising a nutritional agent comprising a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

Contrary to the pending claims, *Lowe '88*, *LabDiet '98* and *Matsuura* all fail to disclose or suggest a method comprising the step of administering a nutritional agent including a prebiotic that comprises about 0.1% to about 20% by weight of a food composition as required, in part, by the present claims. Rather, each of *Lowe '88*, *LabDiet '98* and *Matsuura* teach, at best, use of probiotic microorganisms. *Lowe '88* teaches that treatment with probiotics, such as yeast cultures, rather than prebiotics of the present claims, can treat metabolic problems that result from dietary hypersensitivity. See, *Lowe '88*, pages 280, 283 and 285 (Exhibit F). Moreover, *LabDiet '98*, much like *Marsh* above, teaches a composition containing a probiotic – brewer's dried yeast – instead of the prebiotic required in the present claims. See, *LabDiet '98* (Exhibit G). Finally, *Matsuura* teaches that probiotics, rather than prebiotics, combined with a poly-unsaturated fatty acid and biotin in a prescription diet, can provide prophylaxis against dermatosis. See, *Matsuura*, Abstract and column 2, lines 3-56; see also, specification, page 1, lines 29-32 (Exhibit H).

Further, *Marsh*, *Shields* and *Cavadini*, as discussed above, also fail to disclose or suggest a method comprising the step of administering a nutritional agent including a prebiotic that comprises about 0.1% to about 20% by weight of a food composition as required, in part, by the present claims. Regarding *Shields*, the Examiner admitted the above deficiency in the non-final Office Action dated March 15, 2007. See, non-final Office Action, page 2 (Exhibit A).

Regarding *Marsh*, rather than show evidence in *Marsh* of the use of prebiotics at the levels of the present claims, the Examiner relies on *Marsh* for the teaching of unspecified probiotic-Brewer's yeast at 1.7% on page 16 of *Marsh*. See, non-final Office Action, page 2 (Exhibit A). As a result, *Marsh*, at best, teaches use of probiotics rather than prebiotics. In fact, nowhere does *Marsh* teach use of prebiotics at any level. Instead, *Marsh* generally teaches a dietary supplement comprising zinc and linoleic acid. See, *Marsh*, Abstract (Exhibit E).

Regarding *Cavadini*, the Examiner relied on page 5, lines 22-26 and 54-57 (See, non-final Office Action, page 2 (Exhibit A)), which specifically state as follows:

The dried, ready-to-eat cereal product conveniently contains about 10^4 to about 10^{10} cells of the probiotic micro-organism per gram of the dried cereal product; preferably about 10^6 to about 10^8 cells of the probiotic micro-organism per gram. The dried cereal product may contain about 0.5% to about 20% by weight of the mixture of the probiotic micro-organism and carrier substrate; preferably about 1% to about 6% by weight; for example about 3% to about 6% by weight.

The amount of the dried, ready-to-eat cereal product to be consumed by the human or animal to obtain a beneficial effect will depend upon the size and age of the

human or animal. However, an amount of the dried, ready-to-eat cereal product to provide a daily amount of about 10^6 to about 10^2 cells of the probiotic micro-organism would usually be adequate. [EMPHASIS ADDED]

See, *Cavadini*, page 5, lines 22-26 and 54-57 (Exhibit D). As stated previously, the above passages clearly describe a dried, RTE product containing probiotic microorganisms rather than the prebiotics required by the present claims.

Moreover, *LOWE '88, Marsh, Shields, LABDIET '98, Matsuura* and *Cavadini* do not even teach or suggest any methods for improving or maintaining the coat of a pet in need of same using a nutritional agent that comprises a prebiotic, a probiotic micro-organism and long-chain fatty acids at the levels detailed above, as required by the present claims. In fact, the Examiner has failed to show any evidence in the cited references regarding a method for improving or maintaining the coat of a pet in need of same or the step of feeding or administering to the pet a nutritional composition including a prebiotic, a probiotic micro-organism and a long-chain fatty acid for improving or maintaining the coat.

The Examiner asserts, however, that the prior art as cited feeds non-specified prebiotics, probiotics, and fatty acids to the same animals as Appellants' and that *Shields* repeatedly recites maintaining healthy skin and coat with omega 3 and 6 fatty acids, chicory root, inulin sources, zinc and probiotic lactobacilli feed as in Example 5 of *Shields*. See, non-final Office Action, page 3 (Exhibit A). Appellants respectfully disagree with the Examiner for the following reasons.

First, Appellants have established above that each of the references is deficient with respect to the present claims. Each reference fails to disclose or suggest (a) any methods for improving or maintaining the coat of a pet in need of same and (b) a method comprising the step of administering a nutritional agent including a prebiotic that comprises about 0.1% to about 20% by weight of a food composition.

Second, contrary to the Examiner's assertion regarding *Shields*, Appellants submit that when *Shields* actually refers to skin and hair coat problems in pets, *Shields* only teaches the use of fatty acids to combat the problem, rather than a disclosure of prebiotics as required by the claims. Specifically, *Shields* states:

Skin and hair coat problems have been noted in several breeds including the Chinese Shar Pei, the Chow Chow and the Miniature Poodle. This problem is also accounted for in the subject breed-specific formulations. In addition to a generous supply

of vitamins (B-vitamins, vitamin A) and minerals (zinc and copper in proteinate form which is more available for deposition in hair), the Group Specific Formulas incorporate the latest in fatty acid supplementation technology available today. This involves a careful balance of total omega-6 and omega-3 fatty acids (ratio 4-11) as well as supplementation of a balance of short and long chain compounds in these major classifications to facilitate inflammation management. This is the reason for the supplementation of evening primrose oil and salmon oil in addition to canola oil in the subject formulations. This blend provides insurance for pets which may have low enzyme activities. [EMPHASIS ADDED]

See, *Shields*, column 10, lines 36-48 (Exhibit C).

Third, regardless of what the Examiner asserts regarding *Shields*' disclosure of prebiotics, the Examiner still admits that *Shields* fails to disclose or suggest the specific prebiotic range of the present claims. Moreover, Appellants have established that the remaining references also fail to disclose or suggest this same range. Further, as discussed previously, Appellants' Examples establish that when adding prebiotics into a pet food composition at the claimed ranges, numerous benefits arise such as, for example, increased coat shininess, coat softness, skin hydration score, skin elasticity, reduced transepidermal water loss, reduced oxidative stress, reduced inflammation, and reduced dandruff. See, specification, page 9, lines 29-34; page 10, lines 25-31, and page 12, lines 1-3 and 30-33. Therefore, Appellants establish non-obvious and unexpected results distinguishing the present invention over the prior art.

Accordingly, the combination of *Lowe '88*, *Marsh*, *Shields*, *LabDiet '98*, *Matsuura* and *Cavadini* fail to disclose or suggest every element of the present claims.

VIII. CONCLUSION

Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) with respect to the rejection of Claims 1, 4, 6, 8, 10, 12, 13, 15-17, 19-24 and 30-33. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed by this Board.

Appellants submit a one-month extension fee of \$120.00 herewith. The Director is authorized to charge any other fees that may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal occurs, please indicate the Attorney Docket No. 115808-338 on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY

Robert M. Barrett
Reg. No. 30,142
Customer No. 29157

Dated: April 8, 2008

CLAIMS APPENDIX
PENDING CLAIMS ON APPEAL OF
U.S. PATENT APPLICATION SERIAL NO. 10/070,799

1. A method of maintaining or enhancing the healthy functioning of the skin and coat system of a pet in need of same comprising the step of feeding the pet a food composition comprising a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of the food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of the food composition, and a long-chain fatty acid.

4. A method according to claim 1 in which the prebiotic is selected from the group of inulin, fructooligosaccharides and plant materials which contain inulin and/or fructooligosaccharides.

6. A method for improving or maintaining the coat of a pet in need of same, the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

8. A method according to claim 6 in which the nutritional agent is administered as a supplement to the pet's normal diet.

10. A method according to claim 6 in which the prebiotic is selected from the group of inulin, fructooligosaccharides and plant materials which contain inulin and/or fructooligosaccharides.

12. A method according to claim 6 in which the pet food further comprises a zinc source.

13. A method for improving or maintaining the coat of a pet in need of same, the method comprising administering to the pet a nutritionally complete pet food which contains a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of the pet food, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of the pet food, and a long-chain fatty acid.

15. A method according to claim 13 in which the prebiotic is selected from the group of inulin, fructooligosaccharides and plant materials which contain inulin and/or fructooligosaccharides.

16. A method according to claim 13 in which the pet food contains about 0.1% to about 5% by weight of a prebiotic fiber as the nutritional agent.

17. A method according to claim 13 in which the pet food contains about 10^4 to about 10^{11} cells of a probiotic micro-organism per gram of the pet food as the nutritional agent.

19. A method according to claim 13 in which the pet food further comprises a zinc source.

20. A method for improving or maintaining the skin and coat system of a pet in need of same, the method comprising administering to the pet a nutritional agent which increases the digestion of nutrients in the gastro-intestinal tract of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

21. A method for improving or maintaining the skin and coat system of a pet in need of same, the method comprising administering to the pet a nutritional agent which improves the microflora balance on the skin of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

22. A method for improving or maintaining shininess and softness of the coat of a pet in need of same, the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastrointestinal tract of the pet, wherein

the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

23. A method for improving or maintaining shininess and softness of the coat of a pet in need of same, the method comprising administering to the pet a nutritional agent which increases the digestion of nutrients in the gastro-intestinal tract of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

24. A method of reducing or assisting in the prophylaxis of dandruff in the coat of a pet in need of same, the method comprising administering to the pet a nutritional agent which promotes the growth of bifido- and lactic-bacteria in the gastro-intestinal tract of the pet, wherein the nutritional agent comprises a prebiotic that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid.

30. A method of manufacturing a pet food, the method comprising providing a prebiotic substance that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid in a pet food composition for giving the coat of a pet animal eating it a flourishing appearance.

31. A method of reducing dandruff in a coat of a pet animal in need of same, the method comprising providing a prebiotic substance that comprises about 0.1% to about 20% by weight of a food composition, a probiotic micro-organism that comprises about 0.5% to about 20% by weight of a food composition, and a long-chain fatty acid in a pet food composition and administering the pet food composition to the pet animal.

32. A method according to claim 30 wherein the composition includes chicory.

33. A method according to claim 32 wherein the composition further includes soybean oil.

EVIDENCE APPENDIX

EXHIBIT A: Non-Final Office Action dated March 15, 2007.

EXHIBIT B: Final Office Action dated August 24, 2007.

EXHIBIT C: U.S. Patent 6,156,355 to Shields et al. ("*Shields*"), cited by the Examiner in the Non-Final Office Action dated March 15, 2007.

EXHIBIT D: EP 0862863 to Cavadini et al. ("*Cavadini*"), cited by the Examiner in the Non-Final Office Action dated March 15, 2007.

EXHIBIT E: WO 98/56263 to Marsh et al. ("*Marsh*"), cited by the Examiner in the Non-Final Office Action dated March 15, 2007.

EXHIBIT F: Lowe ("Canine Nutrition – Recent Advances") ("*Lowe '88*"), cited by the Examiner in the Non-Final Office Action dated March 15, 2007.

EXHIBIT G: LabDiet ("Product Reference Manuel") (*LABDIET '98*), cited by the Examiner in the Non-Final Office Action dated March 15, 2007.

EXHIBIT H: U.S. Patent No. 5,756,088 to Matsuura et al. ("*Matsuura*"), cited by the Examiner in the Non-Final Office Action dated March 15, 2007.

RELATED PROCEEDINGS APPENDIX

None